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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,686	04/05/2000	Daryl L. Champagne	200-0090	6796

28395 7590 03/11/2005
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EXAMINER

GART, MATTHEW S

ART UNIT PAPER NUMBER

3625

DATE MAILED: 03/11/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/543,686
Filing Date: April 05, 2000
Appellant(s): CHAMPAGNE ET AL.

Matthew M. Jakubowski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 11, 2004.

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection is correct.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Evidence relied upon by the examiner in the rejection of the claims under appeal is listed below:

Evidence of public use or knowledge of the invention by Toyota is demonstrated via the following periodicals:

"Push is on shorten lead-times for custom car orders," Brian Milligan, Purchasing, Boston, October 7, 1999, Volume 127, Issue 5, page 74. (PTO-892, Ref U)

"Can Car-Makers Emulate Dell? Toyota Tries," Jeffrey Bodestab, Wall Street Journal, Brussels, August 31, 1999, page 10. (PTO-892, Ref V)

"e-Parcel Delivers Data for Toyota's Production Control Division," Business/Technology/Automotive Writers, Business Wire, New York, June 1, 1999, page 1. (PTO-892, Ref W)

"Customers Move into the Driver's Seat: Personalized products become viable with the net," Otis Port, Business Week, New York, October 4, 1999, Issue 3649, page 103. (PTO-892, Ref X)

Other Evidence Relied Upon:

Henson, U.S. Patent No. 6,167,383

Green, U.S. Patent No. 6,041,310

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. The ground(s) for rejection are reproduced below from the final Office Action and are provided here for the convenience of both Appellant and The Board of Patent Appeals.

DETAILED ACTION

Claims 1-44 are pending in the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 13-31 and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over a public use or knowledge of the invention by Toyota in view of Henson U.S. Patent No. 6,167,383.

Evidence of public use or knowledge of the invention by Toyota is demonstrated via the following periodicals:

"Push is on shorten lead-times for custom car orders," Brian Milligan, Purchasing, Boston, October 7, 1999, Volume 127, Issue 5, page 74. (PTO-892, Ref U)

"Can Car-Makers Emulate Dell? Toyota Tries," Jeffrey Bodenstab, Wall Street Journal, Brussels, August 31, 1999, page 10.
(PTO-892, Ref V)

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"e-Parcel Delivers Data for Toyota's Production Control Division,"

Business/Technology/Automotive Writers, Business Wire, New York, June 1, 1999, page

1.

(PTO-892, Ref W)

"Customers Move into the Driver's Seat: Personalized products become viable with the net," Otis Port, Business Week, New York, October 4, 1999, Issue 3649, page 103.

(PTO-892, Ref X)

Referring to claim 1. Toyota discloses an online method of ordering and purchasing customized products, comprising:

- Receiving a custom order message incorporating order data and product configuration data submitted by an online user (Toyota, Page 12: Customers would pick and choose from a menu of onscreen options, then hit a button to send the order straight to the factory. Toyota has been equipping showrooms in Japan with Internet terminals since 1995.);
- Entering the custom order and order data and product configuration into an order bank to be scheduled for manufacturing (Toyota, Page 2: "A quick order"); and
- Canceling the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user (Toyota, Page 1: "The problem now is with last minute changes, whereby a supplier gets a production order and then it is changed...It happens quite frequently now.").

Toyota does not expressly disclose an online method of ordering and purchasing customized products, comprising:

- Storing the order data and product configuration into a buyer database; and
- Generating an order confirmation message and sending the order confirmation message to the user.

Henson discloses an online method of ordering and purchasing customized products, comprising:

- Storing the order data and product configuration into a buyer database (Figure 1, "Database 24"); and

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- Generating an order confirmation message and sending the order confirmation message to the user (Figure 1, "THANK YOU" and column 5, lines 23-27).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Toyota to have included the limitations found in the method of Henson in order to have solved problems that existed in previous generation online stores including a lack of responsiveness to customer requests and an incompleteness of information delivery (column 2, lines 48-58). Furthermore, Henson is assigned to Dell and discloses a method and apparatus for providing customer configured machines at an Internet site. PTO-892, Ref U, explicitly discloses that Toyota is trying to emulate Dell's business model of delivering personal products to order.

Referring to claim 2. Toyota further discloses a method comprising:

- Receiving input entered on a web page by the user to submit a custom order, including product configuration data (Toyota, Page 12: Customers would pick and choose from a menu of onscreen options, then hit a button to send the order straight to the factory. Toyota has been equipping showrooms in Japan with Internet terminals since 1995.");
- Generating the custom order message incorporating the product configuration data and sending the custom order message to a web server (Toyota, Page 2: "The system would make short order to manufacture time possible...customers would be able to place an order, then receive the finished car in just five days."); and
- Routing the custom order message to a workflow manager (Toyota, Page 1: "This system calculates exactly how many of a particular part will be needed at specific points on a production line to assemble certain cars. The information forms that basis of provisional orders to the plant's suppliers.").

Referring to claim 3. Toyota further discloses a method comprising:

- Sending the custom order data to a dealer selected by the user (Toyota, Page 2: "A quick Order"); and
- Routing the custom order message to a B2B server, which sends it to an order processor (Toyota, Page 2: "A quick Order").

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Referring to claim 4. Toyota further discloses a method comprising generating a unique order number for the custom order (Toyota, Page 2: "...an order is given at a dealership; five days later, the manufacturing facility begins making the car. The finished vehicle is then shipped out.").

Referring to claim 5. Toyota in view of Henson discloses a method according to claim 1 as indicated supra. Henson further discloses a method comprising:

- Receiving customer data related to the user from the user (Henson: Figure 7 and Figure 8); and
- Storing the customer data in a common membership database (Henson: Figure 7 and Figure 8).

Referring to claim 6. Toyota in view of Henson discloses a method according to claim 1 as indicated supra. Henson further discloses a method comprising:

- Receiving online payment data from the user for the custom order (Henson: Figure 10);
- Processing the online payment data of the product (Henson: Figure 10); and
- Confirming the online payment processing completion (Henson: Figure 10).

Referring to claim 13. Toyota in view of Henson discloses a method according to claim 1 as indicated supra. Toyota further discloses a method comprising:

- Receiving a lead request message incorporating lead data and product configuration data submitted by the user, the lead-time identifying the online user as a potential customer (Toyota, Pages 1-5);
- Storing the lead data and product configuration into a buyer database (Toyota, Pages 1-5); and
- Generating a lead confirmation message and sending the lead confirmation message to the user (Toyota, Pages 1-5).

Referring to claims 14-18. Toyota in view of Henson discloses a method according to claim 13 as indicated supra. Toyota further discloses a method comprising a lead update status function (Toyota, Page 4: "If a manufacturer could give a supplier a production schedule for four days from today and hold that production schedule, it helps everyone...If a day later, they change it again, the supplier has difficulty determining what he needs to produce.").

Referring to claim 19. Toyota further discloses a method comprising:

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- Receiving a cancel custom order request from the user (Page 2, "According to the plan, dealers can place orders for fully accessorized cars in a 90-day advanced order. They can make changes to some of these cars and strip away certain options in a limited time period, usually a week.");
- Deleting a custom order associated with the cancel customer order request from an order bank (Page 2, "According to the plan, dealers can place orders for fully accessorized cars in a 90-day advanced order. They can make changes to some of these cars and strip away certain options in a limited time period, usually a week."); and
- Updating a buyer database to reflect the updated status of the user (Page 2, "According to the plan, dealers can place orders for fully accessorized cars in a 90-day advanced order. They can make changes to some of these cars and strip away certain options in a limited time period, usually a week.").

Referring to claim 20. Toyota further discloses a method comprising:

- Receiving a cancel tag order request from the user (Page 2, "According to the plan, dealers can place orders for fully accessorized cars in a 90-day advanced order. They can make changes to some of these cars and strip away certain options in a limited time period, usually a week.");
- Modifying data associated with a cancelled tag order in an order bank (Page 2, "According to the plan, dealers can place orders for fully accessorized cars in a 90-day advanced order. They can make changes to some of these cars and strip away certain options in a limited time period, usually a week.");
- Modifying data of a product associated with the cancelled tag order in an enterprise product availability database (Page 2, "According to the plan, dealers can place orders for fully accessorized cars in a 90-day advanced order. They can make changes to some of these cars and strip away certain options in a limited time period, usually a week."); and
- Updating a buyer database to reflect the updated status of the user (Page 2, "According to the plan, dealers can place orders for fully accessorized cars in a 90-day advanced order. They can

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make changes to some of these cars and strip away certain options in a limited time period, usually a week.”).

Referring to claim 21. Claim 21 is rejected under the same rationale as set forth above in claim 1.

Referring to claim 22. Claim 22 is rejected under the same rationale as set forth above in claim 2.

Referring to claim 23. Claim 23 is rejected under the same rationale as set forth above in claim 5.

Referring to claim 24. Claim 24 is rejected under the same rationale as set forth above in claim 4.

Referring to claim 25. Toyota discloses a method according to claim 21 as indicated supra.

Toyota further discloses a method wherein the online order is for customer ordering of a vehicle.

Referring to claims 26-31. Arledge discloses claims 26-31 under the same rationale as set forth above in claims 1-7.

Referring to claims 39-40. Arledge discloses claims 39-40 under the same rationale as set forth above in claims 2-3.

Referring to claim 43. Claim 43 is rejected under the same rationale as set forth above in claim 19 and claim 26.

Referring to claim 44. Claim 44 is rejected under the same rationale as set forth above in claim 20 and claim 26.

Claims 7-12 and 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over a public use of the invention by Toyota in view of Henson U.S. Patent No. 6,167,383, in further view of Green U.S. Patent 6,041,310.

Referring to claim 7. Toyota in view of Henson discloses a method according to claim 1 as indicated supra. Toyota in view of Henson does not expressly disclose a method comprising:

- Displaying a list of products substantially matching product configuration data entered by the online user;
- Receiving a user-tagging of a particular product from the list and a tag order message incorporating tag order data and product configuration data submitted by the user;

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- Storing the tag order data and product configuration into a buyer database;
- Modifying inventory data in an inventory database associated with the tagged product to indicate unavailability; and
- Generating a tag order confirmation message and sending the tag order confirmation message to the user.

Green discloses a method comprising:

- Displaying a list of products substantially matching product configuration data entered by the online user (Green: column 1, lines 17-26 and column 9, lines 15-32);
- Receiving a user-tagging of a particular product from the list and a tag order message incorporating tag order data and product configuration data submitted by the user (Green: Figure 12);
- Storing the tag order data and product configuration into a buyer database (Green: Figure 1);
- Modifying inventory data in an inventory database associated with the tagged product to indicate unavailability (Green: column 10, lines 55-61 and claim 1); and
- Generating a tag order confirmation message and sending the tag order confirmation message to the user (Green: Figure 12A).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Toyota in view of Henson to have included the limitations of Green as discussed above in order to allow customers to sift through myriad choices available for a purchase (Green: column 2, lines 14-24).

Referring to claim 8. Claims 8 is rejected under the same rationale as set forth above in claim 2 and 7.

Referring to claim 9. Claims 9 is rejected under the same rationale as set forth above in claim 3 and 7.

Referring to claim 10. Claims 10 is rejected under the same rationale as set forth above in claim 4 and 7.

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Referring to claim 11. Claims 11 is rejected under the same rationale as set forth above in claim 5 and 7.

Referring to claim 12. Claims 12 is rejected under the same rationale as set forth above in claim 6 and 7.

Referring to claims 32-38. Claims 32-38 are rejected under the same rationale as set forth above in claims 7-12.

(11) Response to ArgumentReferring to claims 1-6, 13-31, and 39-44

The Examiner notes, four periodicals were cited (herein referred to as Toyota) in order to demonstrate a well-defined public use of the claimed invention. The periodicals both sufficiently inform the Public of the invention and would allow a competitor to reasonably ascertain the invention. All of the cited periodicals were published less than one year prior to the filing date of the instant application.

The Appellant argues that the periodicals do not allow a competitor to reasonably ascertain each and every element of the claimed invention and is solely based on impermissible hindsight obtained from the Applicants' teachings (Page 5: Appeal Brief).

The Examiner notes, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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The Appellant recites particular excerpts of the Toyota references in an attempt to illustrate that Toyota did not have possession of the claimed invention at the time of the printed articles (Page 5: Appeal Brief). For example, Ref U, dated October 7, 1999 states "Toyota Motor Corp made headlines recently when a representative said the company is taking steps to quicken the time it takes to build customized Camry Solaras at its manufacturing plant in Canada. The process called Logistics Continuous Improvement, will allow Toyota to start working on the car five days after an order is made." Ref U also states "Mordue says Toyota's system will take much longer than five days. But it will represent a shortened lead-time."

In the final office action, the Examiner specifically pointed to the portions of the periodicals that show a public use or knowledge of the claimed invention. The Appellant cited passages relating to the production of a customize car five days after an order is made. Although, the cited periodical argues the public use or knowledge of an invention to produce a customized car in five days, the cited periodicals explicitly discloses an online method of ordering and purchasing customized products, as claimed in the instant invention. Ref U, dated October 7, 1999 does indeed show a public use or knowledge of the claimed invention. Ref U discloses, "Toyota fully expects the competition to take note of the system, even if it is not as dramatic as originally thought" (Toyota, Ref U: Page 3).

In the Appellant's remarks dated 4/14/2004 and again on page 7 of the appeal brief the Appellant requested the Examiner to identify a date certain for Toyota's alleged public use so the Appellant can fully address this ground of rejection.

As noted in the Final Office action dated 7/28/2004, the instant application claims benefit to a provisional application filed 11/05/1999. Ref U has a publication date of 10/07/1999, Ref V has a publication date of 8/31/1999, Ref W has a publication date of 6/01/1999, and Ref X has a publication date of 10/04/1999.

The Examiner notes, the rejection above fully specifies what limitations are linked to which periodicals. For example, claim 1 relies on Ref U and Ref X; therefore the critical date of public use of claim 1 would be the latest publication date of the two relied upon references (i.e. 10/04/1999).

The Appellant argues that Toyota does not provide evidence for "canceling the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user."

(Page 9: Appeal Brief)

The Examiner notes, the canceling language does not positively recite an action step, it only denotes a situation wherein a product may be cancelable if a relevant party involved in the transaction is not satisfied with the particular order. The limitation, "Canceling the custom order after processing of the custom order is initiated and before the custom order is scheduled for manufacturing if a cancel request is received from the user." is a conditional limitation and is given little patentable weight. In the claims, once

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the positively recited portions are satisfied, the claim as a whole is satisfied -- regardless of whether or not other portions are conditionally invocable under certain other hypothetical scenarios.

However, as noted in the Final Office Action, Toyota does disclose a method wherein, "the problem now is with last minute changes, whereby a supplier gets a production order and then it is changed... It happens quite frequently now" (Toyota, Ref U: Page 1). Toyota is demonstrating a situation wherein a production order is received (custom order) and after the processing of the production order (custom order) the order is changed. Changing an order after processing is equivalent to canceling an original order and replacing the original order with a new order.

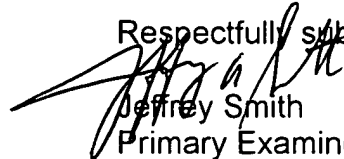
Referring to claims 1-6, 13-31, and 39-44

The Appellant reiterates arguments that were presented and address above.

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



Jeffrey Smith
Primary Examiner
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March 2, 2005

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